

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86610019
LAW OFFICE ASSIGNED	LAW OFFICE 103
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/86610019/large
LITERAL ELEMENT	LOOPER
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_7122590101-20160428191209743199_-_Looper_-_Response_to_OA_ii_confusion_.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT16\IMAGEOUT16\866\100\86610019\xml7\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\866\100\86610019\xml7\RFR0003.JPG
DESCRIPTION OF EVIDENCE FILE	Response and argument document
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	025
DESCRIPTION	
Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic pants; Athletic shirts; Athletic shoes; Baseball caps and hats; Non-leather belts for clothing; Fabric belts; Fashion hats; Golf shoes; Hats; Headbands; Hooded sweat shirts; Hooded sweatshirts; Jackets; Long-sleeved shirts; Men's socks; Pants; Polo shirts; Rain hats; Rain jackets; Rainproof jackets; Shirts; Shoes; Short-sleeved shirts; Socks; Sports jackets; Sports shirts; Sweaters; Sweatshirts; T-shirts; Track jackets; Waterproof jackets and pants; Wind resistant jackets; Wind shirts; Wind-jackets	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	025
TRACKED TEXT DESCRIPTION	
Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic pants; Athletic shirts; Athletic shoes; Baseball caps and hats; Non-leather belts for clothing ; Fashion hats; Fabric belts ; Golf shoes; Hats; Headbands; Hooded sweat shirts; Hooded sweatshirts; Jackets; Long-sleeved shirts; Men's socks; Pants; Polo shirts; Rain hats; Rain jackets; Rainproof jackets; Shirts; Shoes; Short-sleeved shirts; Socks; Sports jackets; Sports shirts; Sweaters; Sweatshirts; T-shirts; Track jackets; Waterproof jackets and pants; Wind resistant jackets; Wind shirts; Wind-jackets	
FINAL DESCRIPTION	
Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic pants; Athletic shirts; Athletic shoes;	

Baseball caps and hats; Fashion hats; Golf shoes; Hats; Headbands; Hooded sweat shirts; Hooded sweatshirts; Jackets; Long-sleeved shirts; Men's socks; Pants; Polo shirts; Rain hats; Rain jackets; Rainproof jackets; Shirts; Shoes; Short-sleeved shirts; Socks; Sports jackets; Sports shirts; Sweaters; Sweatshirts; T-shirts; Track jackets; Waterproof jackets and pants; Wind resistant jackets; Wind shirts; Wind-jackets

FILING BASIS	Section 1(b)
SIGNATURE SECTION	
RESPONSE SIGNATURE	/joshua f morell/
SIGNATORY'S NAME	Joshua F Morell
SIGNATORY'S POSITION	Owner
SIGNATORY'S PHONE NUMBER	267.987.9266
DATE SIGNED	04/28/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Apr 28 19:22:38 EDT 2016
TEAS STAMP	USPTO/RFR-XX.XXX.XX.XXX-2 0160428192238557646-86610 019-5505438448e6225499676 97e7f35ab07bcbfe1b39eb0d9 d1282a68136bc85cf-N/A-N/A -20160428191209743199

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.
PTO Form 1960 (Rev 10/2011)
OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action
To the Commissioner for Trademarks:

Application serial no. **86610019** LOOPER(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86610019/large>) has been amended as follows:

EVIDENCE
Evidence in the nature of Response and argument document has been attached.
Original PDF file:
[evi_7122590101-20160428191209743199_.Looper_-_Response_to_OA_ii_confusion_.pdf](#)
Converted PDF file(s) (2 pages)
[Evidence-1](#)
[Evidence-2](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES
Applicant proposes to amend the following class of goods/services in the application:
Current: Class 025 for Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic pants; Athletic shirts; Athletic shoes; Baseball caps and hats; Non-leather belts for clothing; Fabric belts; Fashion hats; Golf shoes; Hats; Headbands; Hooded sweat shirts; Hooded sweatshirts; Jackets; Long-sleeved shirts; Men's socks; Pants; Polo shirts; Rain hats; Rain jackets; Rainproof jackets; Shirts; Shoes; Short-sleeved shirts; Socks; Sports jackets; Sports shirts; Sweaters; Sweatshirts; T-shirts; Track jackets; Waterproof jackets and pants; Wind resistant jackets; Wind shirts; Wind-jackets
Original Filing Basis:
Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a

bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed:

Tracked Text Description: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic pants; Athletic shirts; Athletic shoes; Baseball caps and hats; ~~Non-leather belts for clothing~~; Fashion hats; ~~Fabric belts~~; Golf shoes; Hats; Headbands; Hooded sweat shirts; Hooded sweatshirts; Jackets; Long-sleeved shirts; Men's socks; Pants; Polo shirts; Rain hats; Rain jackets; Rainproof jackets; Shirts; Shoes; Short-sleeved shirts; Socks; Sports jackets; Sports shirts; Sweaters; Sweatshirts; T-shirts; Track jackets; Waterproof jackets and pants; Wind resistant jackets; Wind shirts; Wind-jackets

Class 025 for Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic pants; Athletic shirts; Athletic shoes; Baseball caps and hats; Fashion hats; Golf shoes; Hats; Headbands; Hooded sweat shirts; Hooded sweatshirts; Jackets; Long-sleeved shirts; Men's socks; Pants; Polo shirts; Rain hats; Rain jackets; Rainproof jackets; Shirts; Shoes; Short-sleeved shirts; Socks; Sports jackets; Sports shirts; Sweaters; Sweatshirts; T-shirts; Track jackets; Waterproof jackets and pants; Wind resistant jackets; Wind shirts; Wind-jackets

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /joshua f morell/ Date: 04/28/2016

Signatory's Name: Joshua F Morell

Signatory's Position: Owner

Signatory's Phone Number: 267.987.9266

The signatory has confirmed that he/she is not represented by either an authorized attorney or Canadian attorney/agent, and that he/she is either: (1) the owner/holder ; or (2) a person(s) with legal authority to bind the owner/holder; and if an authorized U.S. attorney or Canadian attorney/agent previously represented him/her in this matter, either he/she has filed a signed revocation of power of attorney with the USPTO or the USPTO has granted the request of his/her prior representative to withdraw.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86610019

Internet Transmission Date: Thu Apr 28 19:22:38 EDT 2016

TEAS Stamp: USPTO/RFR-XX.XXX.XX.XXX-2016042819223855

7646-86610019-5505438448e622549967697e7f

35ab07bcbfe1b39eb0d9d1282a68136bc85cf-N/

A-N/A-20160428191209743199

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark: LOOPER
Serial No.: 86/610,019
Off. Action Date: October 20, 2015

Response / Argument:

This response and argument is presented to address the Final Office Action dated October 29, 2015.

Rejection Based Upon Likelihood of Confusion Under Section 2(d)

The October 20, 2015 Office Action finally refused registration of my LOOPER mark (the “Mark”) because of a likelihood of confusion with the registered mark LOOPER (U.S. Registration No. 1,120,964). I have reviewed the LOOPER registration and the Office Action in detail. In response to the latest Office Action, I have further amended the pending description of goods for my Mark. In view of those amendments, and the below arguments, I respectfully disagree with the Office Action determination of likelihood of confusion. As briefly discussed with Examiner In, I have also contacted the owner of the LOOPER registration, and we are preparing a consent agreement between us that I will provide in further response to the pending Office Action.

More particularly, with respect to the proposed description of goods with which I will use my LOOPER mark, I have limited that description to remove any reference to belts, whether leather or non-leather belts. Accordingly, the current pending description of goods relevant to my Mark is as follows:

Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic pants; Athletic shirts; Athletic shoes; Baseball caps and hats; Fashion hats; Golf shoes; Hats; Headbands; Hooded sweat shirts; Hooded sweatshirts; Jackets; Long-sleeved shirts; Men's socks; Pants; Polo shirts; Rain hats; Rain jackets; Rainproof jackets; Shirts; Shoes; Short-sleeved shirts; Socks; Sports jackets; Sports shirts; Sweaters; Sweatshirts; T-shirts; Track jackets; Waterproof jackets and pants; Wind resistant jackets; Wind shirts; Wind-jackets; all in Int'l Class 025.

By comparison, the LOOPER registration is only used in connection with “leather goods – namely, purses, billfolds, belts and tool pouches; and handbags made of imitation leather;” all in Int'l Class 018. As noted in a prior response, while the LOOPER registration originally was registered for goods including “watch straps” in Int'l Class 014, and “clothing belts” in Int'l Class 025, both of these latter classes of goods were specifically deleted and registration of the LOOPER mark in connection with watch straps and clothing belts was cancelled. Accordingly, by its own admission, the LOOPER registration is not used in connection with the commercialization of clothing belts or other goods in Int'l Class 025, and is only used in connection with the commercialization of “leather goods” and more specifically in connection

with the commercialization of “purses, billfolds, belts and tool pouches; and handbags made of imitation leather.”

In view of the current limitation of the description of goods for my mark, to remove any reference to belts, as well as there being no citation to leather purses, billfolds, tool pouches, or handbags made of imitation leather, and the fact that the remaining goods identified in my description of goods have no relation to any of the LOOPER registration goods, there is no overlap or any likelihood of confusion between the LOOPER registration and my Mark.

With respect to channels of trade, I note that there does not appear to be any direct website presence for the Looper leather goods. The current owner of the LOOPER registration, Looper Law Enforcement, LLC, appears to only commercialize products through limited third party sites. These sites are limited to advertising and showing leather pistol holsters. None of the sales sites showing Looper pistol holsters appear to show any goods that I will commercialize under my Mark, including athletic apparel, shirts, pants, jackets, footwear, hats and caps, golf shoes; sweat shirts; jackets; or sweaters.” Moreover, it is my intention to commercialize my products through my direct website on-line. Accordingly, the difference in the channels of trade between how the Looper registration products are sold, and how I intend to provide point-of-sale locations for my distinct products further differentiates and obviates any confusion.

In view of the above, I respectfully request reconsideration of the allowance to register my Mark (LOOPER). As noted above, there is no overlap between any of the goods associated with the LOOPER registration and the goods associated with my Mark. Further, I expect to be submitting an agreed consent from the owner of the LOOPER registration acknowledging the distinctions between our respective goods, and there being no opportunity for confusion.

For at least these reasons, I respectfully request that the refusal to register my LOOPER mark be withdrawn, and that my mark be permitted to proceed to allowance, or temporarily suspended to permit submission of the noted consent agreement.